REMARKS

Applicant thanks the Examiner for taking time to discuss this application in the telephone interview. The interview helped focus the issues which are discussed below. Also, please enter the amendment to claim 18, made to correct a typographical spelling error.

Claims 1 – 39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Katz, *et al.* (U.S. Patent Application Publication No. US 2002/0174000) in view of Chandra, *et al.* (U.S. Patent Application Publication No. US 2002/0138582).

Under a § 103 rejection, determination of obviousness must be made under the four factual inquires of *Graham v. John Deere Co.*: (1) Determining the scope and contents of the prior art; (2) Ascertaining the differences between the prior art and the claims in issue; (3) Resolving the level of ordinary skill in the pertinent art; and (4) Evaluating evidence of secondary considerations. As provided in MPEP § 2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitation must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

Furthermore, in establishing a *prima facie* case of obviousness, there must be some motivation or suggestion, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. The references may not be modified by using hindsight-based obviousness. The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985). Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Applicant respectfully asserts that the Examiner has rejected Applicant's claimed invention based upon hindsight-based obviousness. Without Applicant's specification for use as a guide, the limitations that the Examiner has found within the cited references do not teach, suggest or disclose

9

Applicant's claimed invention. The desirability of the modifications to the cited references that are required to be made to produce Applicant's claimed invention are not suggested by the cited references at all. Rather, it is by the impermissible use of Applicant's specification as a blueprint that the cited references are used to reject Applicant's claims.

Applicant claims a computer implemented method that includes, *inter alia*, communicating a query for a proposed action to a plurality of decision-making entities, wherein the query includes a description of the proposed action; and receiving responses to the query from the plurality of decision-making entities, wherein each response includes an indicator of support for the proposed action. (Claim 1, 19). The method further includes, *inter alia*, the computer implemented steps of determining the cumulative support from the query responses received; and automatically implementing the proposed action if the cumulative support is greater than the set point. (Claim 1, 19). The limitations recited in Applicant's claims 1 and 19 provide a computer implemented method for automatically implementing a proposed action *only if* the collective supportive responses to a query that was sent to the a group of decision makers exceed a certain threshold.

Katz discloses a method for managing a workflow process that is directed towards the procurement industry. The method helps a buyer or a seller of component parts to make decisions such as to when to buy a part and what part to buy. Katz provides a system that allows a user to query the *system* and provides notification, or alerts, to users. The *decisions* made in Katz are made either by the user and entered into the system or they are based upon rules that evaluate current system data or workflow responses.

Therefore, it should be noted that Katz does not disclose or teach communicating a query to a   ___ group of decision makers nor does Katz disclose or teach receiving *responses* to the query from the plurality of decision-making entities as Applicant claims. Furthermore, as the Examiner states, Katz does not disclose: 1) maintaining a setpoint representing a minimum cumulative support required to implement a proposed action or 2) determining the cumulative support from the query responses received. For these limitations, the Examiner has cited Chandra.

Significantly, the Examiner rejects Applicant's claims 1 and 19, having the limitation of

10

"automatically implementing the proposed action if *the cumulative support* is greater than the *setpoint*," as being obvious over the prior art by only citing Katz. (Office Action, p. 3). Applicant respectfully asserts that Katz cannot be cited in the rejection of this claim if, as the Examiner has determined as discussed above, Katz does not disclose or teach "maintaining a setpoint" or "determining the cumulative support." For this reason, Applicant respectfully asserts that a *prima facie* case of obviousness has not been presented since there is no citation of prior art that teaches or suggests Applicant's claimed limitation of "automatically implementing the proposed action if the cumulative support is greater than the setpoint." Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 1 and 19, which contain the "implanting the proposed action" limitation, and all the other remaining claims, which depend from either claim 1 or 19.

Looking first at Applicant's claimed limitation of communicating a query, the Examiner states that Katz discloses Applicant's limitation (from claims 1 and 19) "communicating a query to the plurality of decision-making entities, wherein the query includes a description of the proposed action," by citing page 20, column 2, lines 32-44 and page 7, column 2, lines 24-41. (Office Action, page 2). Katz states therein:

> In another example, when a new supplier achieves a status rating (such as a "qualified" rating) for SDRAM or a certain family of DRAM, then the owner of the alert may be notified by email of such an event, invoking the supplier allocation module of module layer 86 to re-calculate the percentage of business that should be allocated to suppliers for SDRAM and/or DRAM. Thus, an alert or plurality of alerts may automatically invoke a module or plurality of modules from module layer 86.

Katz, page 20, column 2, lines 32-44.

Applicant respectfully asserts that this cited passage of Katz does not disclose or teach Applicant's claimed limitation "communicating a *query* to the plurality of decision-making entities" as the Examiner states. (Office Action, page 2). Katz merely discloses sending an "alert" to a group of people, but Katz does not disclose or teach or suggest that the alert contains a *query* communicated to the plurality of decision-making entities as claimed by Applicant.

It is important to note that Applicant uses the word "query" in its usual and customary sense. The Examiner points out that "alert" is defined in one dictionary that is cited by the Examiner as

11

"where one can look around," thereby indicating that a search was being done. (Office Action, p. 10, ln. 6-9). However, Applicant uses the common definition of the word "query" as given in the Merriam-Webster Dictionary: "question, inquiry." Therefore, when Applicant uses the word "query," Applicant does not mean "where one can look around," but instead uses the term in its usual and customary sense, as "question or inquiry."

In the paragraphs following the above citation from Katz, Katz provides an exhaustive list of "alerts" that may be issued. (Katz, paragraphs 265-293). Significantly, not a single "alert" listed by Katz is a query. The "alerts" include, *inter alia*, "The lead time has exceeded a certain limit for a supplier;" (Katz, ¶ 266); "The price for a given component fell below or above a given percentage level from the contract price;" (Katz, ¶ 271). As may be seen, each of these alerts alert the recipient to a *fact*, to something that has *already happened*, and does not communicate a *query* as claimed by Applicant.

In support of the Examiners contention that the *alerts* sent out by Katz are the same as Applicant's claimed *query*, the Examiner states that the system of Katz uses the query/search method to *look for and alert the user to an action that needs to be accomplished*. (Office Action, p. 10, ¶ 1, emphasis added). As noted above, Applicant is not using the word "query" in the sense "to look around" but in the sense of "question." While the Examiner may correctly point out that Katz analyzes a plurality of discovered data, and produces one or more reports or alerts concerning the data, that is not "communicating a query to the plurality of decision-making entities" as Applicant claims. Nor, as the Examiner contends, does Katz teach or disclose herein that the alert is to "an action that needs to be accomplished." As stated above, each of the alerts listed by Katz in paragraphs 266-293 are alerts of an event that *has already occurred* and are not alerts to an action that *needs to be accomplished*.

Significantly, the Examiner has not stated that these "alerts" are in fact "queries" as claimed by Applicant in claims 1 and 19. Furthermore, the Examiner has not contested Applicant's previous assertion that the "queries" listed by Katz are not "queries" at all, because there is no question being asked in these alerts. Nor does the Examiner state that these queries are communicated to "the plurality of decision-making entities" as claimed by Applicant. (Claim 1, 19).

Since Applicant may be his own lexicographer, Applicant uses the word "query" in its usual and customary sense of "question, inquiry." Applicant respectfully asserts that the Examiner has not

12

shown that Katz communicates *a query* (question) *to a plurality of decision-making entities* as claimed by Applicant and has failed to establish a *prima facie* case of obviousness that requires each and every limitation claimed by Applicant be taught or suggested in the cited references. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1 and 19, which contain the limitation not taught or suggested by Katz of communicating a query to the plurality of decision-making entities. Applicant further requests reconsideration and withdrawal of claims 2-18 and 20-39 as being dependant, either directly or indirectly, from claims 1 or 19.

Applicant further claims the limitation of "receiving responses to the query from the plurality of decision-making entities." (Claims 1, 19). The Examiner states that Katz discloses this limitation at Katz, page 23, column 1, lines 31-49. (Office Action, page 3). Katz discloses therein:

> For example, such criteria may include maximizing production, maximizing revenues, maximizing margins, etc. Such an analysis takes into account the production schedule, demand forecast . . . . In response to an alert . . . . the user preferably accesses the functionality of BOM optimization module in module layer 86 through the VCA user interface 208. . . . . The input window, in turn presents the data pertinent to the task of optimal BOM allocation data, such as production schedule, demand forecast, inventory of components . . . . It should be noted that the inventory data for the user-specified part is an example of internal data 30.

Katz, page 23, column 1, lines 31-49.

Applicant respectfully asserts that Katz does not disclose or teach "receiving responses to the query from the plurality of decision-making entities." Instead, Katz discloses that a user may access the functionality of the BOM (Bill of Material) optimization system, thereby showing that a computer can receive and respond to a query *from the user*. However, it is the impermissible use of hindsight based obviousness analysis that modifies the disclosure of Katz - that a user may access the functionality of the BOM system - into Applicant's claimed limitation of "receiving responses to the query from the plurality of decision-making entities." The Examiner has provided no suggestion or teaching from the cited references that show the desirability to modify Katz to Applicant's claimed invention. Without such teaching from the references themselves, Applicant respectfully asserts that the rejection is based upon impermissible hindsight-based obviousness analysis using Applicant's own specification as a blueprint. *Interconnect Planning Corp. v. Feil,* 774 F.2d 1132, 1138 (Fed.

13

Cir. 1985).

As the Examiner states, "It is well known in the art that a user initiated search/query generates a response from the database wherein "response to the query" reads on "user selects a particular part of part family from a search page." (Office Action, p. 11, ¶3). This is impermissible use of hindsight obviousness analysis to suggest that this teaches sending a query *to* a user for response *(i.e.,* a reversal of the computer and user roles). There is no suggestion or motivation within the references themselves to modify the well-known fact that a user query to a database will generate a response into "receiving responses to the query from the plurality of decision-making entities."

Applicant claims that the *system* receives [not that the system generates] responses [plural] to *the* query [the query that was sent *by* the system to the plurality of decision-making entities] from *the* plurality of decision-making entities, wherein *each* response includes an indicator of support for the proposed action." Whether the Examiner determines that the "alert" or the "solution" that Katz discloses may be sent out to users as Applicant's "query" that is communicated to a plurality of decision-making entities, Katz fails to disclose that the *system* receives *responses to the query* [or to the alert or solution] from the *users* [plural] who were sent the query, the alert or the solution. It is important that multiple responses be received from the users because, as Applicant later claims, these multiple responses must be analyzed by the system for "determining the cumulative support from the query responses received." (Claims 1, 19).

Therefore, because Katz does not disclose, teach or suggest Applicant's claimed limitation of "receiving responses to the query from the plurality of decision-making entities," Applicant respectfully asserts that a *prima facie* case of obviousness has been presented. Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1 and 19, which are the independent claims containing this limitation, as well as claims 2-18 and 20-39 which depend, either directly or indirectly, from claims 1 and 19.

Applicant further claims that query responses received from the plurality of decision-making entities "includes an indicator of support for the proposed action." (Claim 1, 19). The Examiner states that Katz discloses this limitation at Katz, page 10, column 1, lines 37-52; page 10, column 2, lines 13-22. (Office Action, page 2). Katz discloses therein:

14

Strategic component identification module: This module preferably provides the user with the ability to identify which components are strategic and which components are tactical, helping the user focus on the most critical components. Strategic components are important to the operations and end product of an enterprise, whereas tactical components are less critical, easier to replace, and often not customized. The strategic component identification module creates a 'criticality rating' based on a predetermined scale, such as 1-10 or 1-100, which is derived from a plurality of variables, which may include any of the following:

Total spent on the part
Number of parts purchased
Cost per part
Revenues and profit impact of the part
BOM analysis to determine which products would be affected by a shortage of this part and how much revenue would be affected by such a shortage. . . .

Katz, page 10, column 1, lines 37-54.

After all the parts have been rated, the module then preferably allows users to select which parts to consider strategic and which tactical by defining a criticality rating threshold for each category. The selected parts are saved and used in subsequent analyses. Users then define different weights for each variable in the formula, thus customizing the formula.

Katz, page 10, column 2, lines 13-19.

Katz, in the cited portion shown above, discloses a module wherein a user can define a criticality rating for different components used in a manufacturing process. These criticality ratings are based upon variables such as a total spent on the part or the number of parts purchased, as stated by Katz above. These are not what Applicant claims. Applicant is not merely claiming that a computer receives rating information and stores it, which is what Katz discloses above. Rather, Applicant claims that specific information is received from a specific source in response to a query and that this specific information is stored. Applicant claims that the system receives *responses* [specific information] from a plurality of decision making entities [specific source], and that each response includes an indicator of support [answer, which is specific information] for the proposed action. (Claims 1 and 19).

Applicant's claimed "indicator of support" is not merely a rating but is the *answer*, or

indicator of support, to the *query* that was sent to the plurality of decision-making entities. Since Katz does not teach, suggest or disclose that multiple responses are received in response to the query sent out by the system, and *these multiple responses each includes an indicator of support for the proposed action*, a *prima facie* case of obviousness has not been presented.

Again, Applicant respectfully asserts that the rejection is based upon the impermissible use of hindsight-based obviousness analysis. Just because a reference could be modified to produce the claimed invention does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Because the cited references do not cite the desirability of the modification, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1 and 19 and the remaining claims depending therefrom.

The Examiner determined that Katz does not disclose Applicant's claimed limitations of maintaining a setpoint representing a minimum cumulative support required to implement a proposed action, and determining the cumulative support from the query responses received (Office Action, Page 3). The Examiner cites Chandra for disclosing Applicant's claimed limitation of "maintaining a setpoint representing a minimum cumulative support required to implement a proposed action," citing Chandra, page 14, column 1, lines 52-67. (Office Action, page 3). As part of a method, Chandra discloses in the cite provided by the Examiner:

> Order Exception Management. Tracks and manages the resolution of a problem that occurs in fulfilling the order. Enables collaboration across the enterprise, partners and suppliers to define the exception and decide on a solution.
>
> Product Configuration. Manages the product configuration process from initial product requirements to configuration and approval. Participants can modify documents and approve or disapprove the final versions.
>
> *Proposal Management. Displays a proposal for review and feedback and compiles sign-off by reviewers or stakeholders.*
>
> Recruiting management. Organizes and streamlines the process of interviewing a candidate, from receiving the resume to making an offer.

Chandra, page 14, column 1, lines 52-67, emphasis added.

16

Applicant respectfully asserts that Chandra does not teach or suggest or disclose therein "maintaining a setpoint representing a minimum cumulative support required to implement a proposed action." While Chandra does disclose that a proposal may be displayed for review and that the system may compile sign-off by reviewers or stakeholders, Chandra does not teach that a *setpoint is maintained* that represents *the minimum cumulative support required to implement a proposed action*. Even if "cumulative support" reads on "compile sign-off" as stated by the Examiner (Office Action, page 3), and Applicant does not agree that it does, Chandra still fails to disclose or teach or suggest "maintaining a setpoint representing a minimum cumulative support required to implement a proposed action."

The Examiner states that Chandra discloses that "once users have indicated their support/collected opinions, there is compile sign-off on the proposed action." (Office Action, p. 12, ¶ 3). However, Applicant respectfully asserts that Chandra discloses the opposite – Chandra discloses that the system "compiles sign-off by reviewers or stakeholders." (Chandra, ¶ 273). "Compiling" is defined in Merriam-Webster as "to collect and edit into a volume." In the proposal management system taught by Chandra, a proposal is displayed to a group of users and sign-offs by reviewers are compiled, or collected, by the system. (Chandra, ¶ 273). Therefore, Chandra does not teach "maintaining a setpoint representing a minimum cumulative support required to implement a proposed action" as claimed by Applicant. (Claims 1, 19).

It is important to note that the Examiner does not cite Chandra for showing that a setpoint is maintained, wherein the setpoint represents the minimum cumulative support required to implement a proposed action. All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). Since all claim limitations must be taught or suggested to maintain an obviousness rejection, a *prima facie* case of obviousness has not been presented since no cite has been provided that includes Applicant's claimed limitation of "maintaining a setpoint." Therefore, reconsideration and withdrawal of the rejection of independent claims 1 and 19, which contain the setpoint limitation, and from all the remaining claims depending therefrom, is respectfully requested.

The Examiner further cites Chandra as disclosing Applicant's claim limitation "determining the cumulative support from the query responses," at Chandra, page 3, column 2, lines 40-57.

17

(Office Action, page 3). Chandra states therein:

> A shared workspace is created in which multiple persons or systems
> can interact within the same transportable application, and all
> responses are *aggregated in one place.* The content of the
> transportable application is current when read; the transportable
> application is constantly updated so users can always see the most
> current information and responses of other group members.
> Transportable applications may be supported by related services. . .
> Transportable applications may generate events that are acted upon by
> other transportable applications, and may act upon events that are
> received form external systems.

Chandra, page 3, column 2, lines 40-57, emphasis added.

Applicant respectfully asserts that this cite does not teach, disclose or suggest *"determining the cumulative support from the query responses."* Chandra teaches that the content of the transportable application is current when read so that users can always see the most current information and responses of other group members. Not only are query responses not mentioned in Chandra, *supra,* but there is no teaching or disclosure that Chandra's computer implemented process *determines* the cumulative support.

The Merriam-Webster dictionary defines determine as "to find out or come to a decision about by investigation, reasoning, or calculation." Applicant uses "determining" in its usual and common meaning, by claiming a computer implemented method that includes the step of "coming to a decision" based upon the cumulative support from the query responses. "Determining" or "coming to a decision" in a computer implemented method is different than the computer implemented method of Chandra that merely updates information and responses so that the most current information may be *viewed by users* of the application. Therefore, Chandra does not teach, suggest or disclose Applicant's claimed limitation of *"determining* the cumulative support from the query responses."

The Examiner further cites Chandra, paragraphs 37-40 to show that Chandra discloses, or teaches or suggests Applicant's claimed limitation of "determining the cumulative support from the query responses." The Examiner states that that Chandra discloses therein that "the software does the 'determining' act dynamically by aggregating this data." (Office Action, p. 12, ¶ 3). Merriam-Webster defines "aggregate" as "formed by the collection of units or particles into a body, mass, or amount." Therefore, Chandra only discloses that data is "gathered" into one place, but Chandra does

18

not show, suggest or teach that the responses or signoffs are aggregated *and then* acted upon to *determine the cumulative support from the responses.*

Nowhere in these cited paragraphs does Chandra suggest or teach that cumulative support from the aggregated responses *is determined*, only that it is, as the Examiner states, aggregated or gathered. Therefore, because Chandra does not teach, suggest or disclose Applicant's claimed limitation of "determining the cumulative support from the query responses," a *prima facie* case of obviousness has not been presented. Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 1 and 19 and for the remaining claims that depend therefrom.

The references cited by the Examiner do not teach, suggest or disclose all the limitations claimed by Applicant in claim 1. First, Katz does not teach, suggest or disclose communicating a *query* to the plurality of decision-making entities as claimed by Applicant.

Second, Katz does not disclose "receiving responses to the query from the plurality of decision-making entities."

Third, Katz does not disclose "includes an indicator of support for the proposed action."

Fourth, Chandra does not teach or disclose "maintaining a setpoint representing a minimum cumulative support required to implement a proposed action" as claimed by Applicant.

Fifth, Chandra does not teach or disclose "determining the cumulative support from the query responses."

Sixth, neither Chandra nor Katz discloses "automatically implementing the proposed action of the cumulative support is greater than the setpoint." The Examiner has only cited Katz to support the obviousness rejection, but citing Katz violates the Examiners determination that Katz does not teach or suggest "maintaining a setpoint' or "determining the cumulative support."
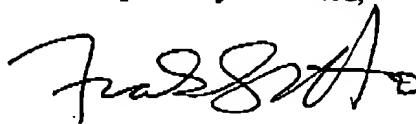
Because each and every claim limitation recited in Applicant's claim 1 is not taught or suggested by the references cited by the Examiner, Applicant respectfully asserts that a *prima facie* case of obviousness has not been presented. As the Federal Circuit has held, and as cited above, the fact that a prior art disclosure may be modified to produce the claimed invention does not make the modification obvious unless the prior art suggested the desirability of the modification. The

teachings and disclosures of Chandra and Katz do not suggest the desirability of modifying their teachings to Applicant's claimed invention Reconsideration and withdrawal of the rejection of the remaining claims is respectfully requested.

If the Examiner believes that a telephone conference will expedite the examination of this application, the Examiner is invited to contact the below signed attorney. In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 09-0447/IBM/0024 as authorized by the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,

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20